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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,128	01/19/2001	Koichi Kawamura	019519-287	8099

7590

02/28/2003

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 02/28/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/764,128

Applicant(s)

KAWAMURA, KOICHI

Examiner

Lawrence D Ferguson

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. This action is in response to the amendment mailed December 27, 2002.  
Claims 2-3 were canceled and claims 1 and 4 were amended rendering claims 1 and 4-7 pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Tashiro et al (U.S. 5,945,240).
4. Tashiro discloses a direct imaging lithographic printing plate comprising a support and an image receiving layer provided thereon, said image receiving layer containing a binder and water soluble compound having hydrophilic functional groups capable of forming a chelate compound with metal ions (abstract and column 1, lines 27-29 and 53-62) where the chelates with metal ions are comprised of at least carboxylic acid group or a sulfonic acid group (abstract). Tashiro discloses surface roughness (column 2, lines 45-46 and column 5, line 56). In claim 1, 'chemically bonded directly to the support surface at its molecular end' is a product by process claim

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limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Tashiro does not disclose the thickness of the image-receiving layer. Even though Tashiro is silent towards the thickness of the image-receiving layer, thickness is result effective and is therefore an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves only routine skill in the art. (See *In re Aller*, 105 USPQ 233 and *In re Boesch*, 617 F.2d (CCPA 1980)).

### ***Claim Rejections - 35 USC § 103***

5. Claims 1 and 4-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Tashiro et al (U.S. 5,939,228).

6. Tashiro discloses a direct imaging lithographic printing plate comprising a support and an image receiving layer provided thereon, said image receiving layer containing a binder and water soluble (hydrophilic) compound having hydrophilic functional groups capable of forming a chelate compound with metal ions (abstract and column 2, lines 30-45) where the chelates with metal ions are comprised of at least

carboxylic acid group or a sulfonic acid group (abstract). Tashiro discloses surface roughness (column 20, line 56). In claim 1, 'chemically bonded directly to the support surface at its molecular end' is a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Tashiro does not disclose the thickness of the image-receiving layer. Even though Tashiro is silent towards the thickness of the image-receiving layer, thickness is result effective and is therefore an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves only routine skill in the art. (See *In re Aller*, 105 USPQ 233 and *In re Boesch*, 617 F.2d (CCPA 1980)).

### ***Response to Arguments***

7. Objection to claim 1 is overcome due to amendment by Applicant. Rejection made under 35 U.S.C. 102(e) as being anticipated by Tashiro et al (U.S. 5,945,240) is withdrawn due to Applicant's amendment of claim 1 incorporating limitations of cancelled claim 2-3. Rejection made under 35 U.S.C. 102(e) as being anticipated by Tashiro et al (U.S. 5,939,228) is withdrawn due to Applicant's amendment of claim 1

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incorporating limitations of cancelled claim 2-3. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Tashiro et al (U.S. 5,945,240) has been considered but is unpersuasive. Applicant argues Tashiro '240 does not disclose or suggest an image receiving layer which contains a polymer compound having hydrophilic functional groups capable of forming chelates together with metal ions and is a straight chained polymer compound that is chemically bonded directly to the support surface at its molecular end. Examiner respectfully disagrees because Tashiro '240 discloses a direct imaging lithographic printing plate comprising a support and an image receiving layer provided thereon, said image receiving layer containing a binder and water soluble compound having hydrophilic functional groups capable of forming a chelate compound with metal ions (abstract and column 1, lines 27-29 and 53-62) where the chelates with metal ions are comprised of at least carboxylic acid group or a sulfonic acid group (abstract). In claim 1, 'chemically bonded directly to the support surface at its molecular end' is a product by process claim limitation (see In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966).

Applicant argues Tashiro '228 does not disclose or suggest an image receiving layer which contains a polymer compound having hydrophilic functional groups capable of forming chelates together with metal ions and is a straight chained polymer compound that is chemically bonded directly to the support surface at its molecular end. Examiner respectfully disagrees because Tashiro '228 discloses a direct imaging lithographic printing plate comprising a support and an image receiving layer provided thereon, said image receiving layer containing a binder and water soluble compound

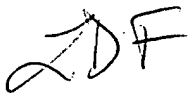
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having hydrophilic functional groups capable of forming a chelate compound with metal ions (abstract and column 2, lines 30-45) where the chelates with metal ions are comprised of at least carboxylic acid group or a sulfonic acid group (abstract. ). In claim 1, 'chemically bonded directly to the support surface at its molecular end' is a product by process claim limitation (see In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966).

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

  
Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SENIOR PATENT EXAMINER  
ART UNIT 1774  
OCTOBER 17 2009

